

Atty. Docket No. Q62891
PATENT APPLICATION

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. Application No. 09/774,877

REMARKS

Claims 1 - 21 are presently pending in the application. The Examiner notes in the Advisory Action of January 28, 2004 that amended claims 1 and 9 require further consideration. Accordingly, a Request for Continued Examination ("RCE") is filed herewith, providing the Examiner the opportunity to further consider the averments herein. Applicant asserts that this Amendment under 37 C.F.R. § 1.114(c) constitutes the submission required in conjunction with filing an RCE, and entry of the amendments provided herein is respectfully directed.

I. Objection to the Disclosure for Informalities

The informalities noted in the instant Office Action are herein corrected by Amendment. Accordingly, the Examiner is respectfully requested to withdraw the objection to the disclosure for informalities.

II. Objections to the Claims for Informalities

The informalities noted in the instant Office Action are herein corrected by Amendment. Accordingly, the Examiner is respectfully requested to withdraw the objection to the claims for informalities.

III. Claim Rejections - 35 U.S.C. § 112, First Paragraph

The Examiner rejects claims 13 - 18 for allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More precisely, the Examiner rejects claims 13 - 18 for the inclusion of the word "temporal." This rejection is respectfully traversed, as explained below.

Atty. Docket No. Q62891
PATENT APPLICATION

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. Application No. 09/774,877

M.P.E.P. § 2163.02 provides guidance on this issue with the following rule: “the fundamental factual inquiry [under § 112, first paragraph,] is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed.” Moreover, “[t]he subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” *Id.*

Therefore, to comply with M.P.E.P. § 2163.02, the word “temporal,” as used in the instant claims, does not need verbatim support in the specification, so long as one skilled in the art would recognize that “temporal” was conveyed with reasonable clarity in the specification-as-filed. As to this issue, the Examiner’s attention is kindly directed to the last full paragraph on page 12 of the Applicant’s specification, for example. Therein, it explicitly states that “image S2 is displayed first, followed by image S4.”

Surely one of skill in the art (even one of little skill in the art) readily recognizes that the terms “first” and “followed by” refer to a temporal order. That is, S2 is *first* in time, *followed by* S4, which is later in time. Therefore, the display protocols are arranged and displayed in a predetermined temporal order. Accordingly, the Examiner is respectfully requested to reconsider and withdraw this rejection, as “temporal” was described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention, as explained above.

IV. Claim Rejections - 35 U.S.C. § 112, Second Paragraph

Claims 13 - 15 and 19 - 21 are rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite (allegedly because claims 13 - 15 recite “each of the display protocols

Atty. Docket No. Q62891
PATENT APPLICATION

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. Application No. 09/774,877

include multiple images” and because claims 19 - 21 recite “comprising multiple images”). These rejections are respectfully obviated in that the allegedly offending language is herein amended from claims 13 - 15 and 19 - 21.

V. Claim Rejections - 35 U.S.C. § 102

Claims 1 - 8 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S.P. No. (“Hilton”). For the following reasons, this rejection is respectfully traversed.

Independent Claims 1 and 5

Independent claims 1 and 5 recite (in various forms to include a method and apparatus) displaying a plurality of images on a display means, wherein, based on at least one display protocol sequence that defines an execution order of a plurality of display protocols for the plurality of images (in which a plurality of display protocols that define a display layout of a plurality of images are lined up in a predetermined order), the display layout of a plurality of images is switched by switching said display protocols by the predetermined order defined in the display protocol sequence and said plurality of images are thus displayed on the display means using the switched-to display protocol. At least these features are altogether absent in the Hilton reference relied upon in the grounds of rejection, as explained below.

Grounds of Rejection Makes Illogical Comparisons Between Features That Operate Differently

The grounds of rejection compares the Hilton reference’s display of a T2 axial series of images (*see* Fig. 3; and Col. 6, line 66, onward), wherein images of sequentially greater data densities are displayed on a single display *in the same position throughout the sequence*, to the instant invention’s recitation of the display being based on at least one display protocol sequence

Atty. Docket No. Q62891
PATENT APPLICATION

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. Application No. 09/774,877

that defines an execution order of a plurality of display protocols for the plurality of images, wherein the images displayed in the image sequence *are not displayed in the same position throughout the sequence because the sequence defines an execution order of a plurality of display protocols for the plurality of images*. Accordingly, in comparing the plain language of the instant invention's claims to the disclosure of Hilton, it is evident that such a comparison is inapposite, as stated above and as further explained below.

Hilton recites at Col. 6, lines 66 onward, that:

The display container is subdivided into a rectangular array of 20 presentation areas. In the monitor mode of image presentation, an image series is shown in a single display container in its sequence order such that each presentation area of the display container includes one image of the sequence. (Emphasis supplied.)

That is, the "sequence" disclosed by the device of Hilton is a sequence for defining the order in which a plurality of images are displayed in the same position in Hilton's display container. In contradistinction, the present invention discloses a sequence in which the plurality of display protocols are executed (wherein the images displayed in the image sequence *are not displayed in the same position throughout the sequence because the sequence defines an execution order of a plurality of display protocols for the plurality of images*). Thus, a physician using the instant invention would not have the burden of arbitrarily reviewing protocols without a methodical order that is predetermined, as would a physician using the device of Hilton.

The Hilton Reference Fails to Teach or Suggest All the Limitations of the Instant Invention

The features of the instant invention are much different from the features of Hilton. That is, independent claims 1 and 5 recite the display of a plurality of images based on at least one display protocol sequence that defines an execution order of a plurality of display protocols for

Arty. Docket No. Q62891
PATENT APPLICATION

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. Application No. 09/774,877

the plurality of images. That is, the instant invention discloses a sequence in which the plurality of display protocols are executed. Such features are altogether absent in the Hilton reference, as noted previously. *See* M.P.E.P. § 2131.

Reconsideration is Respectfully Requested

In light of the differences noted above, it is respectfully averred that independent claims 1 and 5 recite features that are altogether absent in the prior art relied upon as the basis for rejection. *See* M.P.E.P. § 2131. Accordingly, it is respectfully requested that the Examiner reconsider and withdraw this rejection.

Dependent Claims 2 - 4, 6 - 8, 13 - 14, 16 - 17 and 19 - 20

These dependent claims are averred to be patentable at least by virtue of their dependency upon their respective base claims, wherein the respective base claims are averred to be patentable as explained above.

VI. Claim Rejections - 35 U.S.C. § 103

Similar in nature to Part V of this paper, independent claim 9 recites displaying a plurality of images on a display means, wherein, based on at least one display protocol sequence that defines an execution order of a plurality of display protocols for the plurality of images (in which a plurality of display protocols that define a display layout of a plurality of images are lined up in a predetermined order), the display layout of a plurality of images is switched by switching said display protocols by the predetermined order defined in the display protocol sequence and said plurality of images are thus displayed on the display means using the switched-to display protocol. At least these features are altogether absent in the Hilton reference relied upon in the grounds of rejection, as explained in Part V of this paper.

Atty. Docket No. Q62891
PATENT APPLICATION

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. Application No. 09/774,877

Reconsideration is Respectfully Requested

In light of the differences noted above, it is respectfully averred that independent claim 9 recites features that are altogether absent in the prior art relied upon as the basis for rejection. That is, Hilton fails to teach or suggest the above-noted features of independent claim 9, and a "*prima facie* obviousness . . . [rejection requires that] all the claim limitations be taught or suggested by the prior art." *See* M.P.E.P. § 2143.03. Accordingly, it is respectfully requested that the Examiner reconsider and withdraw this rejection.

Dependent Claims 10 - 12, 15, 18 and 21

These dependent claims are averred to be patentable at least by virtue of their dependency upon their respective base claims, wherein the respective base claims are averred to be patentable as explained above. That is, "[i]f an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious." *See* M.P.E.P. § 2143.03.

VII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Atty. Docket No. Q62891
PATENT APPLICATION

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. Application No. 09/774,877

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Jason C. Beckstead
Registration No. 48,232

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: February 27, 2004

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this AMENDMENT UNDER 37 C.F.R. § 1.114(c) is being facsimile transmitted to the U.S. Patent and Trademark Office this 27th day of February, 2004.



Thea K. Wagner